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CHARLES ELMORE

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No.— 246

ALLEN-BRADLEY COMPANY,
Petitioner,

vs.

SQUARE D COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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Aug. 23, 1948.

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INDEX

Page

PETITION FOR WRIT OF CERTIORARI:

A. Summary Statement of Matter Involved..... 1

B. Reasons relied on for Allowance of the Writ.... 4

BRIEF:

The Opinions of the Court Below 6

Jurisdiction 6

Statement of the Case 6

Facts Necessary to an Understanding of the Questions 6

Specification of Errors 11

Summary of Argument 11

The First Question 11

The Second Question 14

The Third Question 15

CONCLUSION 17

Table of Cases

Art Metal Works, Inc. vs. Abraham & Straus, Inc., 107 Fed. (2d) 940, 1939 17

Allen-Bradley Company vs. Square D Company, 168 Fed. (2d) 334; 76 U.S.P.Q. 497 6

Allen-Bradley Company vs. Square D Company, 63 Fed. Supp. 427; 67 U.S.P.Q. 2 6

Best vs. Miller, 167 Fed. (2d) 374 12

Diamond Rubber Co. vs. Consolidated Tire Co., 220 U.S. 428 13

Page

Eibel Co. vs. Paper Co., 261 U.S. 45 15

Glade vs. Walgreen Co., 122 Fed. (2d) 306 (C.C.A. 7th) 1941 15-17

Goodyear vs. Ray-O-Vac, 321 U.S. 275 15

Iron Fireman Mfg. Co. vs. Industrial Corp., 89 Fed. (2d) 904 (C.C.A. 7) 12

Lever Bros. Co. vs. Proctor & Gamble Mfg. Co., 139 Fed. (2d) 633 (C.C.A. 4) 13

Loom Co. vs. Higgins, 105 U.S. 580 15

Luten vs. Kansas City, 285 Fed. 840 15

National Slug Rejectors, Inc. vs. A. B. T. Manufacturing Corporation, 164 Fed. (2d) 333 ..... 4, 11

Nestle-LeMur Co. vs. Eugene, 55 Fed. (2d) 854 (C.C.A. 6) (1932) 13

Seymour vs. Osborne, 11 Wall (U.S.) 516 15

Triangle vs. Rohrlich, et al., (Miss Seventeen Foundation Co.) 167 Fed. (2d) 969 (C.C.A. 2) 12

United States Gypsum Co. vs. Consolidated Expanded Metal Companies, 130 Fed. (2d) 888 (C.C.A. 6) (1942) 13

Williams Manufacturing Co. vs. United Shoe Machinery Corp., 316 U.S. 364 14

240(a) of the Judicial Code (28 U.S.C. Sec. 347) as amended 6

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

To the Honorable the Justices of the Supreme Court of the United States:

The petition of Allen-Bradley Company respectfully represents:

A.

SUMMARY STATEMENT OF MATTER INVOLVED

1. Your petitioner, Allen-Bradley Company (hereinafter called "Allen-Bradley") seeks to review a judgment rendered by the Circuit Court of Appeals for the Seventh Circuit on March 6, 1948 (Rec. p. 2567).

2. Allen-Bradley was plaintiff in an action brought in the District Court of the Northern District of Illinois against Square D Company (hereinafter called "Square D") wherein a judgment was sought that Square

D had infringed two certain patents owned by Allen-Bradley.

3. Upon answering, Square D, by way of counterclaim, sought judgment against Allen-Bradley for infringement of two certain patents owned by Square D.

4. Upon trial, lasting approximately six weeks resulting in an extensive record, the controversy became centered upon one of the two patents of Allen-Bradley and the District Court found that that patent was invalid. The District Court also found the remaining patent of Allen-Bradley to be invalid and the patents upon which Square D was counterclaiming, one to be invalid and the other not infringed. Accordingly, the District Court dismissed both the complaint and the counterclaim. The decree of the District Court appears at (Rec. pp. 109-10) and the opinion of the District Court appears at (Rec. pp. 54-64).

5. On appeal Allen-Bradley, without success, sought to reverse the judgment of the District Court primarily with reference to that patent (*Wilms and Petersen,* No. 2,071,149, Exhibit No. 1, Rec. p. 2481) which was at the center of the controversy, and while a cross appeal was filed with reference to a patent involved under the counterclaim, Square D in effect did not press the merits of its cross appeal. The issues to be determined were virtually concerned with the single patent now in suit, No. 2,071,149. The judgment of the Circuit Court of Appeals affirming the District Court's opinion is found at page 2567 of the Record. The opinion of the Circuit Court of Appeals appears at pages 2553 to 2567 of the Record.

The present petition is filed primarily to secure review of the rule of law applied in measuring patentability of the new and useful subject matter contained in the patent

in suit; which rule of law is inconsistent with, and diametrically opposed to, the measure applied in circuits other than the Seventh Circuit, as well as the measure elsewhere applied within the Seventh Circuit itself and as approved by this court itself to the extent of denying a petition for writ of certiorari.

6. The invention claimed in the patent in suit is an improvement in three phase electric switches for across-the-line starting of machine tool motors. The Circuit Court of Appeals said:

> "* * * The most generous appraisal which we are able to accord to this claimed invention is that the hood was enclosed in such a way as to affect the arcs in a manner that would enable the switch to carry a heavier load". * * * (Rec. p. 2564).

And this is correct connoting as it does that switches can be made in larger capacities.

7. The merit of the improvement was not refuted, either in the District Court or in the Circuit Court of Appeals. Theories advanced by the rival experts as to how the improvement was obtained were in disagreement and in disagreement with the theory of an independent court-appointed expert, but upon appeal the parties were in practical agreement that the impounding of the arcs in ends of the enclosure of each switch by means of the magnetic field was the proper explanation of operation.

8. The novelty involved in the patent in suit as in the case of so many improvements consisted not in a novel element but in a novel combination creating a significant advance in the art of three phase across-the-line motor starters. The exact atomic phenomenon involved was for a time at least baffling. Claims 2, 20, 21, 22, 23, 24 and 26 of Patent 2,071,149 with 21 as typical are involved.

After the decision by the Circuit Court of Appeals as outlined above, petitioner sought a rehearing on the ground that the test of patentability established by the Court in its own decisions when applied to the facts and circumstances in this case called for a determination of patentability and of validity of the claims. The petition was denied on June 29, 1948 (Rec. p. 2568). Thereafter, and within three months, this petition was filed.

B.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

The questions which Allen-Bradley presents for the consideration of the Court and in respect to which the Certiorari is sought are as follows:

First: Where the Court announces as a standard for invention, complying with the requirements of the Statutes as to patentability, that a modicum of utility and a modicum of novelty are sufficient, and in a subsequent decision refuses to apply such standard, is there not such inconsistency as requires the supervisory action of this Court for its resolution?

In the instant case the ruling of the Circuit Court of Appeals while recognizing utility and novelty with reference to the art, held the claims to be not patentable. This is a ruling in conflict with the decision of the Circuit Court of Appeals of the Seventh Circuit in *National Slug Rejectors, Inc. v. A. B. T. Manufacturing Corporation,* 164 Fed. (2d) 333, 335 (certiorari denied), where the Court stated:

> "As to utility, it may be said the invention was of small coverage and of even smaller importance.

If the coin selector made possible the rejection of underweighted coins, or served better to eject such coins, it possessed utility. It is not the extent of the utility that governs, but the existence of *some* utility.

Likewise, as to novelty, the improvement or change may evidence no outstanding or revolutionary difference in mechanism. No giant's stride is demanded. Novelty involves the presence of some element or the new position of an old element in a combination, different from anything found in any prior structure". (Emphasis in the original.)

Second: Where in a suit for patent infringement the patent is attacked as invalid and it appears that the claims of the patent defined a new association of old elements giving rise to improved results, can the claims of said patent be adjudicated invalid upon the ground that the elements are old?

Third: Did not the Circuit Court of Appeals err in crediting admissions or omissions with an effect not consonant with the record and affirming the decree of the District Court which dismissed the Bill of Complaint?

Wherefore, your Petitioner prays that this petition be granted and that a Writ of Certiorari issue to the Circuit Court of Appeals of the Seventh Circuit for the purpose of reviewing the questions hereinbefore specified.

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Dated at Chicago, Illinois, August 23, 1948.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

The Opinions of the Court Below.

The opinion of the Circuit Court of Appeals for the Seventh Circuit is reported at 168 F. (2d) 334; 76 U.S. P.Q. 497, and appears in the record filed herewith (Rec. p. 2553 to 2567).

The opinion of the District Court is reported at 63 F. Supp. 427; 67 U.S.P.Q. 2, and appears of record filed herewith (Rec. p. 54 to 64).

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered March 6, 1948 (Rec. p. 2567).

Petition for rehearing was denied June 29, 1948 (Rec. p. 2568).

The Statute under which jurisdiction is invoked is *240 (a) of the Judicial Code* (28 U. S. C. Sec. 347) as amended.

STATEMENT OF THE CASE

Facts Necessary to an Understanding of the Questions.

1. Petitioner, Allen-Bradley, and respondent, Square D are commercial rivals in the field of furnishing electric switches for across-the-line starting of electric motors for machine tool application.

2. The art long had recognized the desirability of combining in a three phase motor switch the desirable elements of reliability and compactness but was not able to overcome the age old inclination to extinguish an arc by blowing it into the surrounding air, i.e., by arc dis-

persal. (See unsatisfactory efforts of Condit Co., Rec. pp. 459-466 with quadruple break arc dispersal switches and list of prior patents).

In contra distinction to this arc dispersal custom, Wilms & Petersen impounded and cooled the arc within the hood. Dr. Simon, Allen-Bradley's expert, testified with respect to this Rec. p. 1242 as follows:

> "Q. Do you find in any of the patents or prior uses cited by the defendant against the Wilms and Petersen patent in suit any instance of the arcs being cooled in the way Mr. Van Valkenburg has explained in his direct examination?
>
> A. No, there is not a single instance in the art cited in which the arcs are cooled as they are cooled in the Wilms and Petersen switch as explained by Mr. Van Valkenburg."

3. The art prior to the Wilms and Petersen invention culminated in the Wilms and Dawe switch made by Allen-Bradley according to Wilms and Dawe reissue patent 20,094, Rec. p. 2148. This switch had somewhat of an enclosure for the double break contacts but it was not complete and the switch got rid of the arc at its low rating of 7½ horsepower by blowing into the air, i.e. by arc dispersal. Van Valkenburg, defendant's expert, testified, Rec. p. 813, that it was good for only 7½ horsepower.

This Wilms and Petersen switch was good for 25 horsepower and over.

This Wilms and Dawe work and other prior art is completely disposed of by the following testimony of Dr. Simon, Rec. p. 1242.

> "Q. Why is the closed hood more effective in cooling the arcs in the way Mr. Van Valkenburg has

explained than the open hood in the Wilms and Dawe switch?

A. Because the hot gases are driven against the ends of the enclosing chamber, and thereby the heat of the gas is more effectively absorbed and transferred to the arc chamber. Therefore, the arc gases are retained in the hood and in close proximity to the walls of the chamber, and are thereby more effectively cooled than in the Wilms and Dawe switch with the open hood where hot gases are expelled into the outside air and are not confined so as to be rapidly and effectively cooled."

Further, Dr. Simon in referring to an enlarged Wilms and Dawe switch, Pl. Ex.-85, Rec. p. 575, stated:

"And a switch of the same type (as Wilms and Dawe size 1) but enlarged to have a current carrying capacity so that when it is closed it can carry the same current as a size 2 Wilms and Petersen switch, will break down or short circuit at a current of about 240 amperes, which is not sufficient and not satisfactory as we see it for a No. 2 switch". (Parenthetical statements supplied.)

4. An important part of this field is the furnishing of electric switches for three phase electric motors in sizes in excess of 7½ horse-power.

5. Where motors larger than 7½ horse-power are to be controlled by connecting them directly across the line (that is to say, by impressing the full voltage available upon the motor in one step) the switching equipment employed is subject to deterioration and even destruction due to the electric arcs which results upon actuation of the switch.

6. In 1934 Allen-Bradley brought to the commercial market as an accomplished fact a new three phase across-the-line starter switch for larger horse-power motors of

outstanding reliability and of a compactness not theretofore existing in any commercial switch furnished by anyone, including Square D. This switch was a specific embodiment of the matter disclosed and claimed in Wilms and Petersen patent, in suit, No. 2,071,149.

7. At the time, respondent, Square-D acquired a specimen of this new switch and acquainted itself in detail with its construction. See Van Valkenburg testimony. (Rec. pp. 947-9.)

8. Subsequently respondent, Square D, designed and marketed a new three phase across-the-line switch—a substantial copy of the Allen-Bradley switch, embodying as contended by petitioner, Allen-Bradley, the subject matter of the claims of the patent in suit.

9. The new switch of petitioner Allen-Bradley combined, as in the Wilms and Petersen patent in suit, a bottom to close the hood around each pair of double break contacts and a U magnetic loop through the double break contacts to impound the arcs into the ends of the closed hood and the results were:

1. That the arcs are confined within the hood until extinct and flashover is prevented between the contacts inside the hood or through the actuator opening to opposite poles outside the hood.

2. That the arcs have their ionized gas compacted by the U magnetic loop to raise the interrupting capacity to over double the enlarged Wilms and Dawe switch PX-85.

3. That sufficient interrupting capacity is obtained as is required for across the line control of a 25 horse-power motor.

The interior of the switch in the Wilms and Petersen patent is shown in the drawing PX-75, Rec. p. 1376, as

connected in circuit to start and stop a motor operated on a three phase alternating current supply circuit. This drawing also shows the magnetic loop in the circuit of each phase and consisting of the line 10 the stationary contact 8, the moveable contacts 37, the other stationary contact 8 and the line 18 to the motor.

Plaintiff Exhibit 78, Rec. p. 1377, shows the casing for the set of contacts in each phase and the operation of extinguishing the arc in both the Allen-Bradley patented switch and the Square D accused switch, Plaintiff Exhibit 2. Dr. Simon, Plaintiff's expert explained this action picture Exhibit 78 on Rec. pp. 530 to 535.

10. Throughout the prosecution of the application of the patent in suit and throughout a long litigation encompassing a period of upwards of nearly fourteen years, there were divergent or changing views on the part of the patentees, their experts, the experts of respondent and the independent expert of the Court as to the specific phenomenon involved in producing a reliable switch of compact dimension. On appeal however the parties appear to have agreed upon and the Court adopted the view that the impounding of the arcs in the ends of the hood by means of the U-shaped magnetic field was the gist of the desirable result. Throughout all this the fact has remained and is recognized in the decision of the Circuit Court of Appeals, that a distinct step from the standpoint of improvement was made in the switch art upon the introduction of switches made in accordance with the disclosure of the patent in suit. Successful switches continued to be made in forms constituting almost exact embodiments of the drawings of the patent in suit, and the switches of respondent differ therefrom only in non-essential detail.

11. The Circuit Court of Appeals, however, has ignored the legal effect of the advance and improvement in the art resulting from the patent in suit and the legal effect of the novelty of the combination called for by the claims by holding that the prior Wilms and Dawe switch good only for controlling a 7½ horse-power motor, not having a closed hood and operating on the old arc dispersal principle prevented patentable novelty being accorded to Wilms and Petersen.

SPECIFICATION OF ERRORS

The errors which Petitioner will urge, if the Writ of Certiorari is granted, are set forth by the questions presented in the petition for Writ of Certiorari (Supra, pages 4 to 5).

SUMMARY OF ARGUMENT

1. The Circuit Court of Appeals after attributing to Wilms and Petersen a new and useful improvement in three phase control switches of the type shown in the Wilms and Dawe patent, denies invention to the patentees in contravention of the law of the Seventh Circuit as enunciated—with a different bench—in the case of *National Slug Rejectors, Inc. v. A. B. T. Manufacturing Corporation,* 164 Fed. (2d) 333, 335, Petition for Writ of Certiorari denied February 9, 1948, rehearing on Petition denied March 8, 1948. The opinion in that case by His Honor Judge Evans states: (P. 335)

> "As to utility, it may be said the invention was of small coverage and of even smaller importance. If the coin selector made possible the rejection of underweighted coins, or served better to eject such coins, it possessed utility. It is not the extent of the utility that governs, but the existence of *some* utility.
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> Likewise, as to novelty, the improvement or change may evidence no outstanding or revolutionary

> difference in mechanism. No giant's stride is demanded. Novelty involves the presence of some element or the new position of an old element in a combination, different from anything found in any prior structure." (Emphasis original).

The Wilms and Petersen switch qualifies as patentable under this statement of the law.

See also *Iron Fireman Mfg. Co. vs. Industrial Corp.*, 89 F. (2d) 904, 909 (C.C.A. 7).

The desirability of this Court exercising its discretion to dispel the confusion which has arisen within the Seventh Circuit out of decisions such as has been rendered in the instant case at variance with the decision in the Slug case is extremely patent. A like desirability for the Second Circuit is strongly pointed out in the dissenting opinion of Judge Frank in *Triangle v. Rohrlich, et al.* (*Miss Seventeen Foundations Co.*) 167 Fed. (2d) 969, 981, (C.C.A. 2) wherein the following statement occurs:

> "I think that anyone reading the decision in the Best case and the decision here will be in considerable confusion about the doctrine of confusion in this circuit. On that ground, also it seems to me the Supreme Court should review this decision." (p. 981)

Judge Frank was referring to the just previously decided trademark infringement case in the Second Circuit of *Best v. Miller,* 167 F. (2d) 374, in which case a petition for a writ of certiorari has been made to this Court.

Without an authoritative determination by this Court, the success of a plaintiff, seeking to protect his patent in the Seventh Circuit, will continue to depend more on the accident of the Court's composition than on any certainty of settled rule in the Circuit.

The decision of the Court of Appeals in denying invention because of want of utility runs counter to the decisions in the Fourth Circuit; for example,

Lever Bros. Co. vs. Proctor & Gamble Mfg. Co., 139 F. (2d) 633, 638 (C. C. A. 4), where the Court, quoting from the decision of this Court in *Diamond Rubber Co. vs. Consolidated Tire Co.,* 220 U. S. 428, 435, in speaking of an inventor, said:

> "* * * If he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor."

and then, after discussion as to the fact that he need not know the scientific principles underlying his invention but must make a clear description, continues:

> "This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it."

There is another reason why the case should be reviewed and that is that defendant, by slavishly copying plaintiff's structure, is estopped from denying utility. *Nestle-Le Mur Co. v. Eugene,* 55 Fed. (2d) 854, 856 (C. C. A. 6) (1932), p. 856:

> "We have no doubt that by copying and using the patented device the defendant has estopped itself from claiming want of utility in the sense of the patent statute."

United States Gypsum Co. v. Consolidated Expanded Metal Companies, 130 Fed. (2d) 888, 889 (C. C. A. 6) (1942), p. 889:

> "Though it be elementary to do so at this late date in the development of the patent law, it is necessary to recall that three elements are requisite to validity, to-wit: Novelty, utility, and invention. It has been held in adjudications without number,

that one who appropriates the teachings of a patent may not deny the utility of the invention."

2. The Circuit Court of Appeals erred in denying patentable invention to Wilms and Petersen by erroneously stating that the sole novelty was the closing of the hood at the bottom (opinion Rec. p. 2562) after correctly pointing out (Rec. pp. 2558-2559) that the new combination consists of combining (1) a bottom to extend under the bridge bar and close the hood at the bottom and (2) a "U" magnetic loop through the contacts to impound and compact the ionized-arc gas in the closed ends of the closed hood. This is a new and useful combination meeting with surprising commercial success, Rec. p. 357, and should be held patentable under the law.

Further, with respect to the principle, the record amply establishes that impounding and compacting the arcs in a three phase switch by means of the cooperation between the "U" magnetic loop and the closed bottom of the hood was new and in contradistinction from the operation of the prior three phase Condit switch which, because it operated on the old arc dispersal principle, had to have quadruple breaks in order to even remotely approach the range of the Wilms and Petersen switches.

The Circuit Court of Appeals denied to Wilms and Petersen patentable invention on the assumption that they had made only a larger capacity switch whereas even if that had been all that Wilms and Petersen did they should not have been denied patentable invention under *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, where this Court sustained a patent on an automatic heel lasting machine—an improvement on the lasting machine described in an earlier patent by the same inventor and also owned by the owner of the

patent in suit. The prior patented machine would work satisfactorily upon shoes of a small range of sizes but not on a wide range of sizes. This Court said respecting the patent there in suit, p. 366:

> " * * * The improvements embodied in the claims in suit had to do with a new combination of elements for clamping the last in the machine, a new combination of elements for the operation of wipers and tackers in fixed relation to each other and to the heel of the last, and a new combination of means for positioning the last vertically and automatically altering the position during the operation. A manual adjustment was a part of each of these combinations by which the heel clamping, the wiping and tacking, and the vertical positioning mechanisms could be adjusted in advance for different sizes of shoes."

The problem was solved as Wilms and Petersen solved the problem left by their immediate predecessors Wilms and Dawe, by creating a new combination to increase the range of use of the prior device.

Likewise under the doctrine of *Eibel Co. v. Paper Co.,* 261 U.S. 45, sustaining a patent for bringing about a speeding up of the operation of a paper making machine Wilms and Petersen should not have been denied patentable invention.

See also *Seymour vs. Osborne,* 11 Wall (U.S.) 516; *Loom Co. vs. Higgins,* 105 U.S. 580; *Goodyear vs. Ray-O-Vac,* 321 U.S. 275; *Luten vs. Kansas City,* 285 F. 840.

3. The Circuit Court of Appeals erred in according undue importance to the writings and cross-examination of Wilms, one of the inventors, as to the merits of the invention contrary to the law as outlined in *Glade v. Walgreen Co.,* 122 Fed. (2d) 306, (C. C. A. 7th) 1941.

Wilms at the time was a man of some age and looking backward was simply over modest. His testimony given under cross-examination is at variance with the actual facts as to the difficulties experienced by him and Petersen in developing the switch of the patent in suit. This is detailed in the record on pp. 191-200. These experiments were of various kinds, covering a wide field and a large amount of time, e.g., starting with the Wilms and Dawe switch, they tried making the hoods larger (Rec. p. 191); they made the barriers twice as high (Rec. pp. 191-2); they tried different ranges of contacts over "quite a long period of time" (Rec. p. 192); they tried deion plates (Rec. p. 193); they tried a switch wherein the contacts had a resistance parallel to the switch gap (Rec. p. 193); they tried inserting an arc strainer in the bottom (Rec. p. 193); they tried inserting the arc strainer and having barriers on the top (Rec. pp. 193-4); they tried inserting iron between the movable contacts (Rec. p. 195); they tried reducing the size of the gap (Rec. p. 196); they tried making the contacts of coin silver, of zinc silver, and an arc barrier with copper contacts (Rec. p. 197); they tried brass barriers instead of asbestos barriers (Rec. p. 197); they tried various alloys of silver, copper, etc. (Rec. pp. 198-9); and finally cadmium silver contacts in combination with the structure of the arc hood, the movable contact bar and an actuator going through the bottom of this enclosed chamber (Rec. p. 201).

In fine, notwithstanding the inadvertent admission of Wilms, he and his associates conducted long research over a period of almost two years in an attempt to obtain the desired interrupting capacity and ultimately obtained the unexpected result by reason of a combination which compacted the impounded arcs in the ends of the enclosed hood.

The Circuit Court of Appeals should have disregarded the admission in the light of the record herein.

In *Glade v. Walgreen Co.*, 122 F. (2d) 306, 309, the Circuit Court of Appeals itself said:

> "* * * However, it would make no difference if both parties admitted it (the truth of plaintiff's assumption as to invalidity), if in fact, it was not true, for the statute does not contemplate that the court shall be bound by admissions in determining the question of patentability."

To the same effect, see *Art Metal Works Inc. v. Abraham & Straus, Inc.*, 107 F. (2d) 940, 943 (1939) where the Circuit Court of Appeals said:

> "* * * The positions taken by experts and counsel upon the trial cannot control the law of the case."

CONCLUSION

For the reasons stated the writ should be allowed.

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